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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,264	11/14/2003	Robert Bender	GLI-001	3845
959 7590 10/03/2007 LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			EXAMINER LOFTUS, ANN E	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,264

Applicant(s)

BENDER, ROBERT

Examiner

Ann Loftus

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ari Dobner's article titled "Litigation for Sale," published April 1996 in the University of Pennsylvania Law Review.

As to claim 1, Dobner teaches in the Introduction section (pages 1 and 2 as printed for the record) obtaining a pool of funds from one or more investors, selecting intellectual property litigation, financing from said pool of funds said intellectual property litigation and apportioning profit resulting from a settlement of said intellectual property negotiation between at least said investors.

Dobner teaches in the section C. The Practical Impact of Champerty Laws (page 13) that the investor can purchase less than the plaintiff's full interest in the lawsuit. A person of ordinary skill in the art would interpret that to mean that the owner of intellectual property (plaintiff), retaining some interest, would receive some of the proceeds. Thus Dobner teaches apportioning profit resulting from a settlement of said intellectual property litigation between at least said investors and the owner of said intellectual property under dispute.

As far as an owner of intellectual property under litigation paying into the pool a predetermined amount, Dobner teaches an owner investing in litigation in section I The Market for Litigation Financing (page 2). Because the amounts are paid into the pool for the financing before the lawsuit is settled, the amounts are inherently predetermined by the time of payment. As Dobner teaches both an owner investing in litigation and financing through an investor pool, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the two known techniques to have the owner pay into the pool in addition to the investors paying into the pool, in order to give the owner some financial interest in the outcome without bearing the entire cost of the litigation. Combining the two known techniques would be within the ordinary skill of the art and would give predictable results.

As to claim 3, Dobner teaches in Section A. Claim Procurement (page 6) intellectual property disputes selected by expert analysis.

As to claim 4, Dobner teaches a patent dispute in the Introduction (page 1-2).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dobner in view of Official Notice.

As to claim 2, Dobner teaches a portfolio of intellectual property disputes in the Introduction (page 2). Official Notice is taken that it is old and well-known to have a portfolio of investments that exceeds thirty or more investments. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Dobner to add selecting thirty or more intellectual property disputes in order to diversify

and spread the risk of losing. More lawsuits in the portfolio make it more likely to approach the statistical odds of prevailing in an intellectual property dispute, and thus enhance the predictability of the investment.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL
9/21/07


ELLA COLBERT
PRIMARY EXAMINER